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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------|
| 10/775,352  | 02/10/2004  | Maurice M. Paxton    | 11630-1010                      | 1163             |
| 24504   | 7590        | 11/22/2005           |                                 |                  |
| THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP<br>100 GALLERIA PARKWAY, NW<br>STE 1750<br>ATLANTA, GA 30339-5948 |             |                      |                                 |                  |
|   |             |                      | EXAMINER<br>GREENHUT, CHARLES N |                  |
|   |             |                      | ART UNIT<br>3652                | PAPER NUMBER     |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/775,352   | <b>Applicant(s)</b><br>PAXTON ET AL. |  |
|                              | <b>Examiner</b><br>Charles N. Greenhut | <b>Art Unit</b><br>3652              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **I. Specification**

1. The title of the invention may not be descriptive of the claimed invention since the claims appear to be directed to a cushion *for* a forklift and not the forklift/cushion combination. (See the section entitled “ Claim Rejections - 35 USC § 112” below for a further discussion) A new title is required that is clearly indicative of the invention to which the claims are directed.

### **II. Claim Objections**

1. Claim 8 is objected to because “mesh from minus 16 and plus 40” should read, -mesh of minus 16 plus 40- or -mesh from minus 16 to plus 40-.
2. Claim 10 is objected to because “claim9” should read -claim 9-.
3. Claim 13 is objected to because it fails to further limit parent claim 11. Claim 13 includes a “lower surface” equivalent to the “bottom surface” already recited in claim 11.
4. Claim 13 is objected to because it fails to further limit parent claim 11. Claim 13 includes “[a] load engaging surface [that] is semi-cylindrical”, equivalent to the “semi-cylindrical load engaging surface” already recited in claim 11.

### **III. Claim Rejections - 35 USC § 112**

The following is a quotation from the relevant paragraphs of 35 U.S.C. 112:

(2) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1.1. Claim 1 recites the limitation “the upright mounting arm” in lines 12 and 13. There is insufficient antecedent basis for this limitation in the claim.
- 1.2. Claim 1 recites the limitation “the parallel flanges” in line 13. There is insufficient antecedent basis for this limitation in the claim.
- 1.3. With respect to claim 11, it is unclear whether applicant is claiming the combination or subcombination.
- 1.4. With respect to claim 11, it is unclear whether applicant is claiming 1 or 2 cushions since line 12 refers to engagement with the arms.
- 1.5. Claim 12 recites the limitation, “said upright mounting arms” in lines 3-4. There is insufficient antecedent basis for this limitation in the claim since only “an upright support arm” is set forth in the claim.
- 1.6. Claim 13 recites the limitation, “said impact cushions” in line 1. There is insufficient antecedent basis for this limitation in the claim since only a single cushion has been previously set forth in the claim.
- 1.7. Claim 14 recites the limitation, “said cushions” in line 1. There is insufficient antecedent basis for this limitation in the claim since only a single cushion has been previously set forth in the claim.
- 1.8. Claim 15 recites the limitation, “said cushions” in line 2. There is insufficient antecedent basis for this limitation in the claim since only a single cushion has been previously set forth in the claim.

- 1.9. Claim 16 recites the limitation, "said cushions" in line 2. There is insufficient antecedent basis for this limitation in the claim since only a single cushion has been previously set forth in the claim.

#### **IV. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 11-13 and 15-16 is/are rejected under 35 U.S.C. 102(b) as being anticipated by GILLISPIE (US 6,242,070 B1).

1.1. With respect to claim 11, GILLISPIE discloses a molded monolithic body (Col. 2 Li. 35), a semi-cylindrical load engaging surface (Fig. 4), an elongated flat mounting surface (38), a bottom surface (32), and a holding means (56)/(22).

1.2. With respect to claim 12, GILLISPIE additionally teaches parallel flanges (28).

1.3. With respect to claim 13, GILLISPIE additionally teaches a lower surface (32).

1.4. With respect to claim 15, GILLISPIE additionally teaches semi-cylindrical (Fig. 4).

1.5. With respect to claim 16, GILLISPIE additionally teaches flat and parallel (54).

#### **V. Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim(s) 1-2, and 4-10 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over GILLISPIE (US 6,242,070 B1) in view of MCCALL (US 5,639,072 A).

1.1. With respect to claim 1, GILLISPIE discloses a load engaging surface (26), and a mounting surface (38). GILLISPIE fails to teach adhesive and a protective peel away sheet. MCCALL teaches adhesive (41) and a peel away sheet (41). It would have been obvious to one of ordinary skill in the art to modify GILLISPIE with the adhesive and peel away sheet of MCCALL to facilitate mounting the cushion.

1.2. With respect to claim 2, GILLISPIE additionally teaches monolithic (Col. 2 Li. 35).

1.3. With respect to claim 4, GILLISPIE additionally teaches a beveled bottom surface (Fig. 4).

1.4. With respect to claim 5, GILLISPIE additionally teaches semi-cylindrical (Fig. 4).

1.5. With respect to claim 6, GILLISPIE additionally teaches flat parallel surfaces (54)/(38).

1.6. With respect to claim 9, GILLISPIE additionally teaches parallel flanges (28).

1.7. With respect to claim 10, GILLISPIE additionally teaches straps (22).

2. Claim(s) 3 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over GILLISPIE (US 6,242,070 B1) in view of MCCALL (US 5,639,072 A) and further in view of MILLER (US 3,080,080 A).

2.1. With respect to claim 3, GILLISPIE fails to teach rubber. MILLER teaches rubber (Col. 2 Li 15). It would have been obvious to one of ordinary skill in the art to modify

GILLISPIE with the rubber of MILLER in order to absorb shock loads on the forklift.

3. Claim(s) 7, 8 and 14 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over GILLISPIE (US 6,242,070 B1) in view of MCCALL (US 5,639,072 A) and further in view of WAKEFIELD (US 3,896,059 A).

3.1. With respect to claim 7, GILLISPIE fails to teach styrene butadiene. WAKEFIELD teaches styrene butadiene. Styrene butadiene is well-known in the art as a material suitable for bumpers and shock absorbers. (See, for example, HIROTA (US 6,099,055 A), TOMS (US 6,093,468 A), MASUDA (US 5,525,675 A), CHEN (US 5,508,334 A), and ABE (US 5,451,642 A)). It would have been obvious to one of ordinary skill in the art to modify GILLISPIE in view of MCCALL with styrene butadiene, as taught by WAKEFIELD, in order to absorb shock loads on the forklift.

3.2. With respect to claim 8, GILLISPIE fails to teach particulate rubber. WAKEFIELD teaches particulate rubber. Particulate rubber is well-known in the art as a cost-effective and environmentally friendly material suitable for bumpers and shock absorbers. (See, for example, DE BIASE (US 6,120,871 A), DI BIASE (US 5,658,633 A), BREDBECK (US 5,624,078 A), BREDBECK (US 5,522,559 A), and BROWN (US 5,506,274 A)). It would have been obvious to one of ordinary skill in the art to modify GILLISPIE in view of MCCALL with particulate rubber, as taught by WAKEFIELD, in order to absorb shock loads on the forklift. GILLISPIE fails to teach particulate of -16/+40 mesh and 5% to 20% binder. It is also well known in the art that the particle size used in recycled rubber compounds can be varied to achieve

desired material properties, to facilitate handling or forming, or to reduce cost. For example, WAKEFIELD discusses that rubber particles may be reduced to any convenient particle size (Col. 2 Li. 41 et seq.). Furthermore, particulate rubber compositions have been commercially available in varying particle sizes, and used as a cushion, bumper, or shock absorber, since at least May 11, 2000 as evidenced by:

[http://web.archive.org/web/20000511203359/http://www.rubberecycle.com/crumb\\_rubber.htm](http://web.archive.org/web/20000511203359/http://www.rubberecycle.com/crumb_rubber.htm).

It would have been obvious to one of ordinary skill in the art to modify GILLISPIE in view of MCCALL with a rubber having a mesh of -16/+40 in order to achieve shock absorption properties of the cushion appropriate for the intended load. It is also well known in the art that the percentage of binder used in the composition may be varied to achieve the desired material properties as discussed in WAKEFIELD Col 5, Li. 8 et seq. Additionally, Example IV in WAKEFIELD teaches a specific example of manufacture using a percentage by weight binder between 5% and 20%, i.e., 17%. It would have been obvious to one of ordinary skill in the art to modify GILLISPE in view of MCCALL with 5% to 20% binder in order to achieve a stiffness of the cushion appropriate for the intended load.

3.3. With respect to claim 14, GILLISPIE additionally teaches a monolith. GILLISPIE fails to teach particulate rubber. WAKEFIELD teaches particulate rubber. Particulate rubber is well-known in the art as a cost-effective and environmentally friendly material suitable for bumpers and shock absorbers. (See, for example, DE BIASE (US



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6,120,871 A), DI BIASE (US 5,658,633 A), BREDBECK (US 5,624,078 A), BREDBECK (US 5,522,559 A), and BROWN (US 5,506,274 A)). It would have been obvious to one of ordinary skill in the art to modify GILLISPIE in view of MCCALL with particulate rubber, as taught by WAKEFIELD, in order to absorb shock loads on the forklift. GILLISPIE fails to teach particulate of -16/+40 mesh and 5% to 20% binder. It is also well known in the art that the particle size used in recycled rubber compounds can be varied to achieve desired material properties, to facilitate handling or forming, or to reduce cost. For example, WAKEFIELD discusses that rubber particles may be reduced to any convenient particle size (Col. 2 Li. 41 et seq.). Furthermore, particulate rubber compositions have been commercially available in varying particle sizes, and used as a bumper or shock absorber, since at least May 11, 2000 as evidenced by:

[http://web.archive.org/web/20000511203359/http://www.rubberecycle.com/crumb\\_rubber.htm](http://web.archive.org/web/20000511203359/http://www.rubberecycle.com/crumb_rubber.htm).

It would have been obvious to one of ordinary skill in the art to modify GILLISPIE in view of MCCALL with a rubber having a mesh of -16/+40 in order to achieve shock absorption properties of the cushion appropriate for the intended load. It is also well known in the art that the percentage of binder used in the composition may be varied to achieve the desired material properties as discussed in WAKEFIELD Col 5, Li. 8 et seq. Additionally, Example IV in WAKEFIELD teaches a specific example of manufacture using a percentage by weight binder between 5%


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and 20%, i.e., 17%. It would have been obvious to one of ordinary skill in the art to modify GILLISPE in view of MCCALL with 5% to 20% binder in order to achieve a stiffness of the cushion appropriate for the intended load.

## **VI. Conclusion**

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Greenhut whose telephone number is (571) 272-1517. The examiner can normally be reached on 7:30am - 4:00pm EST.
3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.
4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CG

  
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